REMARKS

Entry of this response is proper under 37 CFR §1.116, since there are no new claims, claim amendments, or issues raised herein. There are no new claim amendments, but a clean version of the current claims is included for reference.

Claims 1, 7, 8, and 15-20 are all the claims presently pending in this application. All other claims have been canceled in reliance upon the Examiner's previous indication of allowable subject matter.

It is noted that the amendments, if any, are made only to more particularly define the invention and not for distinguishing the invention over the prior art, for narrowing the scope of the claims, or for any reason related to a statutory requirement for patentability. It is further noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1 and 15 stand rejected under 35 U.S.C. §103(a) as unpatentable over US Patent Publication No. 20070060212 to Shah, further in view of US Patent Publication No. 2004/0192412 to Ono et al. Claims 7, 8, 13, 14, 19, and 20 stand rejected under 35 U.S.C. §103(a) as unpatentable over Shah/Ono, further in view of GB 2,343,335 to Okano. Claims 16-18 stand rejected under 35 U.S.C. §103(a) as unpatentable over Shah/Ono, further in view of US Patent 7,062,303 to Usami.

These rejections are respectfully traversed in view of the following discussion.

I. APPLICANT'S CLAIMED INVENTION

The claimed invention, as defined, for example, by independent claim 1, is directed to a mobile terminal including, a battery, a power supply block which supplies power of the battery, a radio communication block which communicates with a base station when the power is supplied from the battery through the power supply block, a first switch which is interposed between the power supply block and the radio communication block, a key operation section to which the power is always supplied from the battery through the power supply block, and a control unit which controls the first switch to stop the power supply from the battery to the radio communication block to stop communication between the mobile terminal and the base station in response to a manual operation of the key operation section, a base band block which is connected with the first switch, an application function block to

which the power is always supplied from the battery through the power supply block and is possible to accomplish application functions, and a second switch which is interposed between the application function block and the base band block, wherein the power supply to the base band block is stopped when the control unit controls the first switch to stop the power supply from the battery to the radio communication block in response to the manual operation of the key operation section, and wherein the control unit is contained in the application function block and controls the second switch to disconnect the base band block from the application function block.

The claimed invention, as defined, for example, by independent claim 15, is directed to mobile terminal including, a battery, a power supply block which supplies power of the battery, a radio communication block which communicates with a base station when the power is supplied from the battery through the power supply block, a first switch interposed between the power supply block and the radio communication block, a key operation section to which the power is always supplied from the battery through the power supply block, a base band block to which the power is always supplied from the battery through the power supply block which accomplishes application functions other than a communication function using the radio communication block, a second switch interposed between the base band block and the radio communication block, a control unit which is responsive to a manual operation from the key operation section that controls the first switch to stop the power supply from the battery to the radio communication block, and controls the second switch to stop communication between the base band block and the radio communication block.

These two exemplary embodiments demonstrate a configuration in which the application functions include at least one function interrelated with the communication block, such that the application function will automatically attempt to have the communication block make contact with a base station.

The present invention includes a second switch so that the applications functions can be fully isolated from the communication block, so that the mobile terminal can be used in areas that there is no usable base station (e.g., during trips) but the user wishes to continue to use one or more applications. The present invention permits the mobile terminal to be used in such areas without causing excessive power drain due to one or more application function attempting to automatically establish contact with a base station.

II. THE PRIOR ART REJECTIONS

The Examiner alleges that one having ordinary skill in the art would have been motivated to modify primary reference Shah by Ono to render obvious claims 1 and 15, would have been motivated to further modify Shah/Ono by Okano to render obvious claims 7, 8, 13, 14, 19, and 20, and would have been motivated to further modify Shah/Ono by Usami to render obvious claims 16-18.

Applicant respectfully disagrees, since, as previously explained, even if Shah were to be combined with secondary reference Ono, the combination would not result in the claimed invention of claims 1 and 15. Therefore, the Examiner has failed to establish a *prima facie* rejection, since there would still be at least one element not demonstrated even if these two references were to be combined.

More specifically, the Examiner concedes that primary reference Shah fails to teach or suggest a second switch interposed between the application function block and the base band block and relies upon secondary reference Ono, pointing to Figures 2 and 3.

However, Applicant respectfully disagrees that these two figures in Ono satisfy the plain meaning of the claim language of independent claims 1 and 15, since the switching means 1021 and 1025 shown in these figures provide switching between the application function block and the main display unit (Figure 2) and between the application function block and the audio function (Figure 3). Therefore, these switches 1021, 1025 do not connect/disconnect the application function block from the communication block. Rather, they control whether the audio/display data is connected to either the communication block or to the applications funciton block.

In contrast, the claimed invention requires that the second switching be between the applications function block and the base band block, a concept entirely different from switching the connections to output devices such as audio and visual display units. The switching in Ono merely switches the audio and display data to either its communication block or to its appications function block. There is no switch in Ono that satisfies the plain meaning of the claim language for the second switch of connecting/disconnecting the communication block/applications function block.

The reason that the switching configuration of the claimed invention is significant in the present invention, compared to the configurations taught in Shah and Ono, is that the present invention provides two exemplary embodiments having application functions in which at least one application function is related to the communication function, such that the

related application function will cause the device to expend large amounts of power by continuously attempting to communicate with a base station. One example is described at lines 16-18 of page 1, wherein is described the call waiting function that operates while other applications other than the communication function is used.

The claimed invention permits these related application functions to be fully disconnected from the communication function, thereby precluding the application functions from attempting to interact with the communication function. In one exemplary embodiment, the applications functions are located outside the base band block, as described in independent claim 1, and in another exemplary embodiment described by independent claim 15, the application functions are incorporated into the base band block.

Thus, in both exemplary embodiments, the claimed invention describes a second switch used to selectively disconnect the application functions from the communication block. As discussed above, this description is entirely different from the connection/ disconnection in secondary reference Ono of the display and audio to be either to its processor for telephone functions or to its processor for application functions, as shown in Figures 2 and 3 of Ono. That is, the switching means 1021, 1025 of Figures 2 and 3 of Ono merely connect the main display unit 103 and the audio function part 106 to be connected to either its telephone control part 1022, 1026 or its applications processor 1023, 1027.

The Examiner relies upon the other cited references for reasons unrelated to overcoming this fundamental deficiency of primary reference Shah, so that these additional references do not overcome this deficiency in Shah. Therefore, in order to establish a *prima facie* obviousness rejection based on Shah, the Examiner would have to provide a reasonably rationale to modify the configuration of Shah to have such second switch as described by the independent claims.

Hence, turning to the clear language of the claims, in Shah, even if modified by Ono, there is no teaching or suggestion of: " ... a second switch which is interposed between said application function block and said base band block, wherein the power supply to said base band block is stopped when said control unit controls said first switch to stop the power supply from said battery to said radio communication block in response to said manual operation of said key operation section, and wherein said control unit is contained in said application function block and controls said second switch to disconnect said base band block from said application function block", as required by independent claim 1. The remaining independent claim has similar language, and Applicant submits that all pending claims are clearly patentable over Shah.

Therefore, Applicant submits that there are features of the present invention which are not demonstrated in Shah, even if modified by the cited secondary references and even if it were consider proper to modify Shah by these secondary references, and the Examiner is respectfully requested to reconsider and withdraw this rejection based on Shah.

Moreover, Applicant submits that the rejection of record fails to provide a reasonable motivation to modify primary reference Shah by Ono, since the switching means 1021, 1025 shown in Figures 2 and 3 of Ono would serve no useful purpose in the configuration shown in primary reference Shah. That is, unlike secondary reference Ono, the configuration shown in primary reference Shah clearly shows an RF unit that already segregates the application functions from the RF unit 14, as confirmed by the description in paragraph [0015]: "*The computing unit 16 provides the local functionality of the device 10....*"

Therefore, in the configuration shown in Shah, when the power switch 12 disconnects power to the RF unit 14, there is clearly no need to provide audio or display to the unpowered RF unit 14. Moreover, there also would be no need to disconnect the audio/display when the RF unit 14 is powered down, since there would be no power to operate any audio/display devices that might be present in the RF unit 14 of Shah. Thus, secondary reference Ono demonstrates switching means 1021, 1025 that would serve no reasonably purpose in the configuration of Shah.

Therefore, one of ordinary skill in the art would not have been motivated to modify Shah to add the switching means 1021, 1025 of Ono, since such modification would have no practical benefit.

Moreover, as explained above, the switching means 1021, 1025 of Ono do not satisfy the plain meaning of the claim language, since these swithes do not connect the applications function processor to the telephone processor. Rather, these switches control whether the main display unit 103 and audio function part 106 are connected/disconnected to the telephone processor, a function not related to the claimed invention.

The analysis for dependent claims 7, 8, and 16-20 inherit the deficiencies identified above for the rejection of their respective independent claims, so that these claims are clearly also patentable over Shah.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1, 7, 8, and 15-20, all of the claims presently pending in the application, are patentably distinct over the prior art of record

and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview. The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 06/03/09

Frederick E. Cooperrider
Reg. No. 36,769
Sean M. McGinn, Esq.
Reg. No. 34,386

McGinn Intellectual Property Law Group, PLLC
8321 Old Courthouse Rd., Suite 200
Vienna, Virginia 22182
(703) 761-4100
Customer No. 21254

CERTIFICATION OF TRANSMISSION

I certify that I transmitted via facsimile to (571) 273-8300 this Amendment under 37 CFR §1.116 to Examiner F. Alam on June 3, 2009.

Frederick E. Cooperrider
Reg. No. 36,769